

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

VIRTAMOVE, CORP.,	§	Case No. 2:24-cv-00093-JRG
	§	(Lead Case)
Plaintiff,	§	
	§	
v.	§	JURY TRIAL DEMANDED
	§	
HEWLETT PACKARD ENTERPRISE	§	
COMPANY,	§	
	§	
Defendant.	§	

VIRTAMOVE, CORP.,	§	Case No. 2:24-cv-00064-JRG
	§	(Member Case)
Plaintiff,	§	
	§	
v.	§	JURY TRIAL DEMANDED
	§	
INTERNATIONAL BUSINESS	§	
MACHINES CORP.,	§	
	§	
Defendant.	§	

**DEFENDANT INTERNATIONAL BUSINESS MACHINES CORP.'S
STATEMENT OF UNDISPUTED MATERIAL FACTS IN SUPPORT OF ITS
MOTION FOR SUMMARY JUDGMENT OF NO WILLFUL INFRINGEMENT**

1. VirtaMove asserts that during prosecution of “U.S. Patent App. No. 12/146,322 (assigned to IBM), US. Patent No. 8,893,306 (assigned to IBM), and U.S. Patent No. 9,166,865 (assigned to IBM),” the patent examiner cited the ’814 Patent. *See* Ex. 1 (VirtaMove Responses to IBM Interrog. No. 3).

2. U.S. Patent App. No. 12/146,322 is not (and never was) assigned to IBM, but instead assigned to AT&T Intellectual Property I, L.P. Ex. 4 (U.S. Pat. App. No. 12/146,322) at pg. 1. During the prosecution of IBM’s U.S. Pat. No. 9,166,865, the examiner cited U.S. Pat. App. 05/0060722 (*i.e.*, the patent application that later issued as the ’814 Patent), but did not cite the ’814 Patent itself. *See* Ex. 3 at 6/11/15 Notice of References Cited. During prosecution of IBM’s US. Pat. No. 8,893,306, the examiner cited the ’814 Patent, but did not substantively discuss it or rely on it as the basis for any rejection. Ex. 2 (File History of US. Patent No. 8,893,306); *id.* at 11/26/12 Notice of References Cited. IBM did not describe or otherwise discuss the ’814 Patent (or its published application) during the prosecution of these two IBM patents. *See* Exs. 2-3 (File Histories of US. Patent Nos. 8,893,306, and 9,166,865).

3. VirtaMove asserts that IBM had acquired pre-suit knowledge of the ’814 Patent during the course of business interactions and discussions between the parties. *See generally* Ex. 1 (VirtaMove Responses to IBM Interrogatory Nos. 1–3, 5–6); Ex. 5 (VirtaMove Responses to IBM Interrogatory No. 27).

4. For example, VirtaMove asserts that between 2003 and 2004, Mr. O’Leary, one of the named inventors for the ’814 Patent, [REDACTED]

[REDACTED] *See id.*; Ex. 6 (VM_IBM_0001692) at -1702; Ex. 7 (VM_IBM_0001766) at -1797, -1805.

5. Mr. O’Leary’s logbooks [REDACTED]
[REDACTED]

See Ex. 8 (Wicker Op. Rpt.) ¶¶ 91–103; *see generally* Exs. 6-7, 9-10 (O’Leary Logbooks).

6. The USPTO issued the '814 Patent to Trigence Corp, a predecessor to VirtaMove (f/k/a AppZero), on April 14, 2009. Ex. 11 ('814 Patent) at Cover.

7. At no point during the course of its interactions with IBM did VirtaMove specifically identify the '814 Patent to IBM, nor did VirtaMove suggest to IBM that it was infringing or would require a license to the '814 Patent, let alone identify any alleged infringing products. Ex. 12 (VirtaMove 05/29/25 Response to IBM Request for Admission No. 40); Ex. 13 (Stokes 5/21/25 Tr.) at 467:10–521:21; Ex. 14 (O'Connor 5/15/25 Tr.) at 258:22–259:24, 279:18–284:6, 341:23–343:6; Ex. 15 (Rochette 5/5/25 Tr.) at 17:10–18:23; Ex. 16 (O'Leary 5/14/25 Tr.) at 200:11–201:15 (same); Ex. 17 (Huffman 5/21/2025 Tr.) at 52:2–53:17 (same); Ex. 18 (Falk 5/13/25 Tr.) at 23:21–24:20, 78:3–23; Ex. 19 (Devine 5/29/25 Tr.) at 66:23–72:25.

8. VirtaMove admits that “it did not identify the Asserted Patents by patent number in any written communication prior to the filing of the complaint.” Ex. 12 (VirtaMove 5/29/25 Response to IBM’s Request for Admission No. 40).

9. VirtaMove’s former CEO, Greg O’Connor, testified [REDACTED]
[REDACTED] Ex. 14 (O’Connor 5/15/25 Tr.) at 258:22–
259:24; 279:18–284:6; 341:23–343:6. VirtaMove’s current CEO, Nigel Stokes, testified [REDACTED]

Ex. 13 (Stokes 5/21/2025 Tr.) at 468:1-7; *see also generally id.* at 467:10–521:21.

10. Mr. O'Connor testified that

Ex. 14 (O'Connor 5/15/2025 Tr.) at 259:9–24; *see also id.* at 258:22–259:24, 279:18–284:6, 341:23–343:6. Mr. Stokes testified that [REDACTED]

[REDACTED] Ex. 13 (Stokes 5/21/2025 Tr.) at 468:25–470:24; *see also id.* at 467:10–521:21.

11. The '814 Patent's named inventors testified [REDACTED]
[REDACTED] See Ex. 15 (Rochette 5/5/2025 Tr.) at 17:10–18:23 [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]; Ex. 16 (O'Leary 5/14/2025 Tr.) at 200:11–201:15; Ex. 17 (Huffman 5/21/2025 Tr.) at 52:2–53:17.

12. IBM employee Walter Falk, whom VirtaMove identifies in support of its willful infringement theory, *see* Ex. 1 (VirtaMove Responses to IBM Interrogatory No. 3), testified that he had “no knowledge of ever discussing patents with AppZero.” Ex. 18 (Falk 5/13/2025 Tr.) at 78:18–23. Similarly, IBM employee Mac Devine, whom VirtaMove also identifies in support of its willful infringement theory, *see* Ex. 1 (VirtaMove Responses to IBM Interrogatory No. 3), testified that VirtaMove never specifically identified the '814 Patent to IBM. *See* Ex. 19 (Devine 5/29/2025 Tr.) at 66:23–72:25.

13. VirtaMove's articles, press releases, and blog posts discussing Kubernetes and/or Docker technology do not state that the use of Kubernetes and/or Docker would infringe. *See* Ex. 20 (VM_IBM_0000425) (V-Maestro Datasheet discussing Docker containers); Ex. 21 (VM_IBM_0000427) (V-Migrate Datasheet discussing Docker containers); Ex. 22 (VM_IBM_0031260) at -1261 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; Ex. 23 (VM_IBM_0030244) [REDACTED]

[REDACTED]; Ex. 24 (VM_IBM_0001958) (October 18, 2016 press release stating, “The new version lets you move . . . [to] Docker-compatible Windows containers”); Ex. 25 (VM_IBM_0001923) (April 21, 2017 article stating, “Version 7.0 lets you move . . . [to] Docker-compatible Windows Containers on 2016.”); Ex. 26 (VM_IBM_0041772) [REDACTED]

[REDACTED]; Ex. 27 (VM_IBM_0001963) (February 5, 2019 article stating, “Stateful legacy re-installs do not require install scripts, source code, or the significant permanent overhead of Windows containers or orchestration tools such as Docker”); Ex. 28 (VM_IBM_0001915) (January 15, 2020 article stating, “You can now easily move legacy applications . . . to new Linux Docker container”); Ex. 29 (VM_IBM_0029966) ([REDACTED])

[REDACTED]; Ex. 30 (VM_IBM_0042423) ([REDACTED]);

Ex. 14 (O’Connor 5/15/25 Tr.) at 256:7–259:2 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED], 316:9–325:5 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] VirtaMove publicly acknowledged [REDACTED]

[REDACTED]

[REDACTED] See Ex. 22 (VM_IBM_0031260) at -1261 [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

14. By late 2021, VirtaMove attempted [REDACTED]

[REDACTED]

[REDACTED] See Ex. 31 (VM_IBM_0000457) at -0461–62; Ex. 32 (VM_IBM_0034925) at -4927.

15. In 2023, VirtaMove discussed [REDACTED]

[REDACTED]

[REDACTED] See Ex. 33 (VM_IBM_0035102) at -5103 ([REDACTED]
[REDACTED]); Ex. 13 (Stokes 5/21/25 Tr.)
at 525:23–569:21 [REDACTED]

[REDACTED] see also Ex. 34 (VM_IBM_0035059) [REDACTED]
[REDACTED]; Ex. 35 (VM_IBM_0035060) (same); Ex. 36 (VM_IBM_0035063) (same).

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Respectfully submitted,

/s/ Todd M. Friedman

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served on July 28, 2025, with a copy of this document via electronic mail.

/s/ Todd M. Friedman
Todd M. Friedman

CERTIFICATE OF AUTHORIZATION TO FILE UNDER SEAL

I hereby certify that the foregoing document is authorized to be filed under seal pursuant to the Protective order entered in this matter.

/s/ Todd M. Friedman

Todd M. Friedman